

O/0536/25

INTERIM DECISION

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK NUMBER UK00003490021
REGISTERED IN THE NAME OF BEREAL
IN RESPECT OF THE FOLLOWING TRADE MARK:**

BE THE REAL

AND

**AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NUMBER 507952
BY BEREAL WEAR LIMITED**

BACKGROUND AND PLEADINGS

1. Trade mark number 3490021 for the mark “BE THE REAL” (“the contested mark”) stands registered in the UK in the name of BeReal (“the Proprietor”). It has a filing date of 14 May 2020 and a registration date of 14 August 2020. The contested mark is registered for *Clothing* in Class 25.

2. On 24 October 2024, BeReal Wear Limited (“the Cancellation Applicant”) filed an application for a declaration of invalidity under section 47 of the Trade Marks Act 1994 (“the Act”). In pursuit of the invalidation, the Cancellation Applicant relies upon sections 3(1)(b), 3(6) and 5(4)(a) of the Act. The invalidation is targeted at the contested mark in full.

3. Under section 3(1)(b), the Cancellation Applicant claims that the contested mark is devoid of distinctive character on the basis that ‘be the real’ is a “common promotional, laudatory and or (sic) aspirational” phrase.

4. Under section 3(6), the Cancellation Applicant claims that the application for the contested mark was made in bad faith on the basis that firstly, there has allegedly been no use of the contested mark in the time since its filing and secondly, the contested mark was sold to an intermediary and then sold onto the Proprietor.

5. Under section 5(4)(a), the Cancellation Applicant claims to have established goodwill in the unregistered mark “BeReal”, which it alleges to have used in the UK since 1 May 2020 in respect of clothing and the retail of clothing. The Cancellation Applicant claims that use of the contested mark would amount to misrepresentation that would damage its goodwill.

6. The Proprietor filed a defence and counterstatement requesting that the Tribunal either issues summary judgment on the basis that there is no reasonable prospect of success, or strikes out the invalidity application on the basis of estoppel/abuse of process. In the alternative, the Proprietor denied the entirety of the Cancellation Applicant’s grounds, putting it to proof of all the claims made.

7. The requests to issue summary judgment or to strike out the application on the basis of estoppel/abuse of process were refused by the Tribunal and the defence was served on 29 January 2025. In the serving letter, copied to both parties, the Tribunal communicated the Cancellation Applicant's evidence in chief deadline of 31 March 2025 and wrote:

"In accordance with Tribunal Practice Notice 2/2010 a period of two months is allowed for the [cancellation] applicant to submit evidence and submissions (please see Glossary), as appropriate. **You should therefore file your evidence and submissions on or before 31 March 2025** and in accordance with rule 64(6) a copy must be sent to the other party. [...]

[...]

Your attention is drawn to Tribunal Practice Notices (5/2008) and (1/2015) regarding the filing of evidence in inter partes proceedings in trademarks and designs cases.

Details on how to file evidence during tribunal proceedings are available from the IPO website [...]

[...]

Failure to file evidence by the due date may result in your application being deemed withdrawn." [Original emphasis]

8. On 27 February 2025, the Cancellation Applicant requested the proceedings be suspended until June on the basis of active negotiations between the parties, indicating that the Proprietor wished to also suspend the proceedings. The Cancellation Applicant did not copy the Proprietor into this correspondence and so, on 28 February 2025, the Tribunal wrote to the parties asking for the Proprietor's consent to jointly stay the proceedings (in accordance with Tribunal Practice Notice ("TPN") 1/2009). The Cancellation Applicant contacted the Tribunal on 2 March 2025 repeating its request for a suspension.

9. On 13 March 2025, the Proprietor contacted the Tribunal (copied to the Cancellation Applicant) to confirm it did not wish to stay the proceedings.

10. Also on 13 March 2025, the Cancellation Applicant contacted the Tribunal, noting the Proprietor's refusal to stay the proceedings and requesting a two-month extension of time to file its evidence on the basis that it was "unable to allocate efforts or costs toward collecting evidences (sic) [and negotiating with the Proprietor] simultaneously".

11. The Tribunal replied to the Cancellation Applicant's request for an extension of time by way of a letter, copied to both parties, on 17 March 2025, which stated:

"In order for the Registry to consider your request, you will be required to file a Form TM9, with £100 fee, to request an extension of time. The Registry would expect any request for an extension of time to include full and detailed reasons in support. It should include information to show what progress has been made in evidence collation, why the evidence could not be filed in the initial period and what needs to be done in the extended period. Your attention is drawn to Tribunal Practice Notice 2/2011. A copy of the Form TM9 should be sent to the other party in the proceedings.

The [cancellation] applicant's evidence or Form TM9 should be filed on or before 31 March 2025."

12. On 31 March 2025, the Cancellation Applicant's evidence deadline, neither evidence nor a Form TM9 ("TM9") had been filed. On the same day, however, the Cancellation Applicant requested, by email to the Tribunal, a two-week extension to file a TM9 on the basis that the parties were finalising the terms of a draft settlement agreement. Requesting an extension of time in order to file the form needed to formally request an extension of time is not the correct procedure. The Tribunal did allow the Cancellation Applicant until 14 April 2025 to file a TM9 but made it clear in its email response that an extension to the evidence deadline would not be considered until a TM9 was filed, stipulating that the form should clearly outline the progress made to date and the reasons why more time was needed to prepare evidence.

13. On 13 April 2025, the Cancellation Applicant did not file evidence or a TM9 but again asked for a further 'suspension' for two weeks, stating:

"We wish to inform the Registry that both parties have now finalised the key terms of the agreement and are actively progressing towards finalising the draft agreement. In light of this, we respectfully request whether it would be possible to hold or suspend the matter for a further two weeks. This additional time would allow both parties to finalise the agreement and bring clarity to the situation, with a view to resolving the matter amicably."

14. On the basis that the Cancellation Applicant had not filed a TM9, there was no extension of time request to consider. Rather, the Tribunal refused the Cancellation Applicant's request to suspend the proceedings (in order to pursue negotiations) on the basis that the Proprietor, on 13 March 2025, had already declined to agree to a mutual stay. The Tribunal's response, sent by letter to both parties on 23 April 2025, was as follows:

"I refer to your email dated 13 April 2024, requesting the above proceedings are stayed. As per the Registered Proprietor's correspondence dated 13 March, they did not agree to a stay request (which must be mutually agreed). The proceedings are therefore not stayed. Neither are the proceedings suspended.

The Cancellation Applicant has brought proceedings under sections 5(4)(a), 3(1) and 3(6), all of which require evidence.

The Tribunal advised the Cancellation Applicant, in correspondence dated 17 March 2025, that the correct procedure to request an extension of time to file evidence is to file a Form TM9. The Tribunal offered, in correspondence dated 1 April 2025, a period of two weeks for the Cancellation Applicant to file a Form TM9 (a TM9R would now be required for a retrospective extension of time, given the evidence deadline has passed).

The Cancellation Applicant has not filed evidence in support of the invalidity proceedings and has not filed the required form to request an extension of time to file its evidence. Accordingly, the Registry's preliminary view is to strike out the invalidity proceedings. If either party wishes to be heard on the matter, they must request a Case Management Conference (CMC) on or before **Wednesday 30th April 2025**. If a CMC is requested, it will take place on **Wednesday 7th May at 2pm**. [...]" [Original emphasis]

15. The Cancellation Applicant, on 24 April 2025, notified the Tribunal that it disagreed with the preliminary view and requested the CMC. The Cancellation Applicant made further reference to ongoing negotiations with the Proprietor.

The Case Management Conference

16. The CMC took place before me on 7 May 2025, to discuss the preliminary view to strike out the proceedings. By the date of the CMC the Cancellation Applicant had still not filed any evidence or a TM9/TM9R.

17. During the CMC, the Cancellation Applicant set out its reasons for not having filed its evidence: these all centred around the parties having been in negotiations. I advised the Cancellation Applicant that these reasons alone were not sufficient to justify an extension to the evidence deadline at that point in time; the Proprietor had not agreed to stay the proceedings and so any negotiations should have been pursued separately to the Tribunal proceedings.

18. It was clear at the CMC that the parties had a difference of opinion on the status of the settlement discussions, however, this was somewhat immaterial to the issue at hand. Even if the Cancellation Applicant was under the impression that the settlement discussions were more sincere than the Proprietor would disclose at the CMC, the fact remained that the Proprietor, within a reasonable time following the Cancellation Applicant's request to suspend the proceedings and prior to the Cancellation Applicant's evidence deadline, declined to a mutual stay of proceedings, as it is entitled to do. The Tribunal was clear that given that the proceedings were not

stayed/suspended the Cancellation Applicant was required to file evidence accompanied by a TM9/TM9R as necessary.

19. At the CMC, the Cancellation Applicant queried whether the proceedings could continue without evidence. I communicated that they could not given the grounds relied upon; evidence would be required to prove the Cancellation Applicant's claims.

20. The Cancellation Applicant asked for further time to file evidence/submissions before the Tribunal made a decision on striking out the proceedings. I allowed the Cancellation Applicant seven days from the date of the CMC to file material it deemed relevant, alongside a TM9R. I made it clear that relying solely on the submission that the parties had been negotiating was not, by itself, a compelling reason by this point in the proceedings given that it was already clear to the parties that the proceedings were not stayed for the purpose of pursuing settlement. I stressed that if the reasons provided in the TM9R were a repeat of those given in the CMC, the request would likely be refused and the evidence/submissions not admitted.

The Cancellation Applicant's TM9R

21. The Cancellation Applicant filed evidence/submissions alongside a TM9R on 14 May 2025. The reasons for requesting an extension of time were listed as: (1) active negotiations and procedural fairness; (2) preserving the Cancellation Applicant's position (in the event that the parties do not reach settlement); and (3) misleading conduct by the Proprietor (i.e. not giving the Tribunal an accurate account of the settlement discussions). I will deal with each of these separately.

DECISION

Relevant provisions

22. In considering the reasons provided in the TM9R and in considering whether to uphold the Tribunal's preliminary view to strike out the proceedings, I refer to the statutory provisions, case law and guidance set out below.

23. Rule 42 of the Trade Marks Rules 2008 (“the Rules”) states:

“(1) Where the proprietor has filed Form TM8, the registrar shall send notice to the applicant inviting the applicant to file evidence in support of the grounds on which the application is made and any submissions and to send a copy to all the other parties.

(2) The registrar shall specify the periods within which evidence and submissions may be filed by the parties.

(3) Where –

(a) [...]

(b) the application or part of it is based on grounds other than those set out in section 5(1) or (2); or

(c) [...]

the applicant shall file evidence supporting the application.

(4) Where the applicant files no evidence under paragraph (3), the applicant shall be deemed to have withdrawn the application to the extent that it is based on –

(a) the matters in paragraph (3)(a) or (b); or

(b) [...]

24. TPN 2/2011, cited in the Tribunal’s letter to the Cancellation Applicant on 17 March 2025, states:

“2. Following the filing of a defence, the Tribunal sets and notifies the parties of the timetable for filing evidence and/or submissions (as per the periods set out

in TPN 2/2010¹). The timetable is to be adhered to. [...] The Tribunal will, **in exceptional cases**, consider requests to extend the time allowance. Such requests will need to be fully supported with explanations as to not only what has been done to date but, more particularly, what is left to do and how long it will take to produce the evidence. [...]"

25. In *AJ and MA Levy's Trade Mark* [1999] RPC 291, the Appointed Person held, at paragraph 10, that it is incumbent upon the party to ensure that, if an extension is to be sought, strong and compelling reasons for such an extension are put forward.

26. In *Siddiqui's Application* (BL O/481/00), the Appointed Person held that in a normal case, the applicant is required to show clearly what they have done, what they have left to do and why it is that they have not been able to do it, so that the Registrar can be satisfied that the reasons merit granting the extension.

Considerations

27. I turn now to the TM9R. In relation to 'active negotiations', I explained at the CMC that this reason being cited would not, by itself, be a compelling reason to grant an extension at this point in the proceedings. This might have been a more persuasive factor when the Cancellation Applicant first sought to request an extension of time on 13 March 2025. However, given that the Proprietor did not agree to a joint stay of proceedings and the Tribunal advised the Cancellation Applicant that the proceedings would continue, the matter of negotiations became a less relevant consideration. By the time the CMC took place on 7 May 2025 and the TM9R was eventually filed on 14 May 2025 (more than six weeks after the original evidence deadline), there had been multiple instances of communication between the Tribunal and the Cancellation Applicant. I would expect to see, on the TM9R, reasons why, despite the Tribunal advising on multiple occasions that a TM9/TM9R needed to be filed, the Cancellation Applicant continuously failed to do so.

¹ This TPN was also cited by the Tribunal in its letter to the Cancellation Applicant on 29 January 2025; the contents of the TPN will not be reproduced here.

28. Turning to 'procedural fairness' I am cognisant of the requirement for procedural fairness in regard to all parties. It is my view that the Cancellation Applicant was fairly given ample opportunity to file either evidence or the correct form on which to request an extension. I must consider the fairness to the Proprietor whose mark is the subject of this invalidation, who has adhered to all deadlines set by the Tribunal and who has been put to the added time and cost implications of the Cancellation Applicant not doing so. In the circumstances, 'procedural fairness' is not a satisfactory reason for requesting an extension.

29. With regards the Cancellation Applicant's right to preserve its position, I return to the number of occasions the Tribunal advised the Cancellation Applicant to either file its evidence or file a TM9/TM9R. The right time to preserve its position (by filing evidence in case settlement was not reached, for example) would have been by the deadline that the Tribunal set, particularly once it was aware that the Proprietor did not agree to stay proceedings. Alternatively, the Cancellation Applicant could have attempted to preserve its position by filing a TM9/TM9R: (i) as soon as possible after the Tribunal advised that that was required (on 17 March 2025); (ii) by the (admittedly generous) extension of 14 days (to 14 April 2025); or (iii) as a last resort, prior to the CMC. The Cancellation Applicant had, in my view, ample opportunity to preserve its position and it chose not to do so.

30. Finally, I note the Cancellation Applicant's allegations of the Proprietor having misled the Tribunal by giving an inaccurate account of the settlement discussions. As explained at the CMC, the Proprietor was within its rights to not agree to a stay of proceedings. Further, the detail of the settlement discussions is not required to be shared with the Tribunal. This is not a compelling reason for granting an extension of time in these proceedings.

Conclusions

31. The reasons provided by the Cancellation Applicant, even when considered together, are not sufficiently strong or compelling for me to be satisfied that a retrospective extension of time is justified under the circumstances, those circumstances being the multiple opportunities the Cancellation Applicant was

provided. Even after the Tribunal's preliminary view to strike out the proceedings, on 23 April 2025, the Cancellation Applicant still made no attempt to file any evidence or the TM9R. I am conscious of the fact that the Cancellation Applicant is not legally represented, but this is not an excuse for failing to follow the rules as set out by the Tribunal itself or by the relevant provisions set out above.² This is even more the case since the Tribunal has clearly set out what the Cancellation Applicant needed to do, and it was not done within the time allowed.

32. On the basis that no evidence has been admitted into the proceedings, it is my view that there is no prospect of success of the grounds of invalidation: those under sections 3(1)(b), 3(6) and 5(4)(a). The arguments, as set out in the pleadings referred to at my paragraphs 3 to 5, cannot be proven without evidence.

33. In accordance with Rule 42(4)(a), cited above, the application for a declaration of invalidity against UK trade mark number 3490021 is deemed withdrawn.

COSTS

34. The Proprietor has been successful and is entitled to a contribution towards its costs. The parties have not made submissions on costs and so I allow 14 days from the date of this interim decision for the parties to file submissions on costs. Either on receipt of the submissions, or if no submissions are received by **Monday 30 June 2025**, I will issue a supplementary decision confirming any costs award, at which point the appeal period will be set.

Dated this 16th day of June 2025

Mrs E Fisher
For the Registrar

² See the comments of Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, in the case at BL O/399/15, paragraph 18.